REMARKS

Reconsideration of the present application is respectfully requested. In this amendment, claims 1-3, 16-18 and 25 have been amended and claims 34-40 have been added. Claims 10-15 were previously canceled. No claims have been canceled in this amendment. Claims 1-9 and 16-33 are pending.

In the Final Office Action, claims 1-3, 5, 6, 8, 9, 16-18, 20, 21, 23, 25-27, 29, 30, 32 and 33 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent no. 6,687,242 of Enzmann et al. ("Enzmann") in view of U.S. Patent application publication no. 2002/0019225 of Miyashita ("Miyashita"). Claims 4, 19 and 28 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Fleming. Claims 7, 22 and 31 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Ho et al. Claims 9, 24 and 33 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Armanto.

The present invention relates to a technique by which a mobile communication device can automatically populate a contact database in the mobile communication device. In certain embodiments, the device responds to the occurrence of a voice call (either an incoming call or an outgoing call) by automatically obtaining data associated with a telephone number of the call via a wireless network, and then storing that data in a contact database in the mobile device in association with the telephone number. For example, in response to an outgoing voice call, a mobile phone may automatically obtain, via the network, contact information (e.g., the name and address) of the

person/entity being called and then store that contact information in a contact database in the mobile phone. Or, in response to an incoming call, the name and address of the caller can be automatically obtained via the network and stored in the contact database of the mobile phone. As another example, in response to an incoming voice call, a mobile phone may automatically obtain, via the data connection, a ring tone associated with the caller and then store that ring tone in the contact database in the mobile phone. Of course, the claimed invention is not limited to these specific examples.

Referring now to the claims, claim 1 as amended recites:

> 1. (Previously presented) A method of automatically populating a contact database in a mobile communication device configured to communicate voice and data over a wireless network, the method comprising, **in response to a call event representing a voice call** involving the mobile communication device:
>
> obtaining a telephone number associated with the voice call involving the mobile communication device; and
>
> when a data connection is established between the mobile communication device and a remote processing system via the wireless network, then
>
> **automatically and without any user input** obtaining data associated with the telephone number via the wireless network, and
>
> storing the data in the contact database in association with the telephone number.
>
> (Emphasis added.)

No combination of the cited references discloses or suggests *all of the limitations* of the present invention, as claimed, nor does any such combination render the present invention *as a whole* obvious.

The Examiner states, "It is not clear whether Enzmann teaches storing the data in the contact database in association with the telephone number." Office Action, p. 4. Applicants respectfully submit that Enzmann does not teach or suggest such

functionality. The Examiner contends that Miyashita discloses storing the data in the contact database in association with the telephone number, and that it would be obvious to combine such teaching in Miyashita with the teachings of Enzmann.

I. Not All Limitations of the Invention Disclosed/Suggested

In the Advisory Action, in response to Applicant's arguments filed on 6/5/2006, the Examiner states:

> Regarding claim 1, the arguments appear to suggest that automatically obtaining and storing data associated with the telephone number in a contact database in a mobile communication device in response to a call event representing a voice call involving the mobile communication device **without a manual user action**. However, the claims only recite automatically obtaining and storing data associated with the telephone number in a contact database in a mobile communication device in response to a call event representing a voice call involving the mobile communication device. Enzmann combined with Miyashita teach this limitation. Advisory Action, continuation sheet (emphasis added).

Applicant respectfully submit that the term "automatically" *means* "without a manual user action". Nonetheless, to remove any doubt on this issue, Applicant has inserted the phrase "and without any user input" following the word "automatically" in each of the independent claims. Applicant respectfully submits, however, that this insertion is completely redundant to the term "automatically".

In contrast with the present invention, no combination of Enzmann and/or Miyashita discloses or suggests a method in which, in response to a call event representing a voice call involving a mobile communication device, data associated with the telephone number is obtained *automatically (without any user input)* and stored in a contact database in the mobile communication device. In fact, both Enzmann and

Miyashita *teach away* from this approach, by teaching that a *user action is required* to cause the device to obtain the additional information. See, e.g., Enzmann abstract and col. 1, lines 58-63; and Miyashita at paragraph [0021], second sentence.

For at least this reason, therefore, the present invention is patentable over the cited art.

II. No Suggestion/Motivation to Combine

Furthermore, there is no suggestion or motivation in the prior art to combine the teachings of Miyashita with those of Enzmann. The alleged motivation cited by the Examiner is: " . . . in order to retrieve contact information from the storage whenever a person needs to contact without any inconvenience." Final Office Action, p. 6. Applicant finds no support in the prior art for that bare bones, conclusory allegation.

Applicant argued this point in the response filed on 6/5/2006, and in the Advisory Action the Examiner responds as follows:

> The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivations do so found either in the references themselves or the knowledge generally available to one of ordinary skill in the art. . . . In this case, Enzmann provides the suggestion for one of ordinary skill in the art will be able [*sic*] to make many variations modifications of the embodiments in light of the disclosure without departing from the spirit and scope of the invention has disclosed herein in col. 5, lines 56-61. Advisory Action, continuation sheet (emphasis added).

Applicant respectfully submits that "the showing [of suggestion to combine the references] *must be clear and particular*" findings of fact based on *actual evidence*, not merely broad conclusive statements. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)(emphasis added). In referring to col. 5, lines 56-61 in Enzmann, the Examiner

merely cites a very general, "boilerplate" statement at the end of Enzmann's description, which appears in essentially this same form in many/most of the thousands of patent applications that are filed every year. That general statement does not even come close to being the necessary factual showing for establishing the required motivation/suggestion. In the present case, the Examiner clearly has not supported his allegation of motivation/suggestion with any clear or particular finding of fact based on actual evidence. The Examiner clearly is relying solely upon hindsight that is improperly *based only on Applicant's disclosure*. The suggestion or motivation to combine references may not be found using hindsight gleaned from the applicant's specification. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). While hindsight may be unavoidable to some extent in evaluating obviousness, it is never permissible *when it is gained from an applicant's disclosure*. *Id.*

For this additional reason, therefore, the present invention is patentable over the cited art.

Independent claims 16 and 25 contain limitations similar to those discussed above regarding claim 1 and are, therefore, also patentable over the cited art for similar reasons.

New claim 34

New claim 34 is similar to independent claim 1, however, it specifies that the voice call which involves the mobile communication device is an *outgoing call*. See also

dependent claims 3, 18 and 27, which also provide that the call is an outgoing call. The cited references do not disclose or suggest, either individually or in combination, a method in which, in response to a call event representing an *outgoing* voice call, data associated with the telephone number is obtained *automatically (without any user input)* and stored in the contact database in the mobile communication device. The technique in Enzmann, for example, is specifically responsive to *incoming* calls, not outgoing calls. See Enzmann at col.1, lines 36-37. Therefore, in addition to the reasons stated above, claim 34 is further patentable of a cited art for this additional reason.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is believed to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Conclusion

For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 10/5/06

Jordan M. Becker
Reg. No. 39,602

Customer No. 26529
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300